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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,638	01/31/2002	Robert Eugene Jevons	5007117-1	1833

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SPENCER, FANE, BRITT & BROWNE
1000 WALNUT STREET
SUITE 1400
KANSAS CITY, MO 64106-2140

EXAMINER

COHEN, AMY R

ART UNIT PAPER NUMBER

2859

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,638

Applicant(s)

JEVONS ET AL.

Examiner

Amy R Cohen

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 19 February 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 19 February 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of an angle between the first and second legs of the base member at 22.5 degrees as shown in Fig. 9.

Specification

2. The amendment filed 19 February 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: an angle between the first and second legs of the base member at 22.5 degrees.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

3. Claim 1 is objected to because of the following informalities:

Claim 1, lines 4-5 claim language is confusing because it is unclear as to whether the front edge of the first and second legs is the same as the unobstructed front edge. If so, proper antecedent basis should be used when further limiting the back and front edges.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The an angle between the first and second legs of the base member at 22.5 degrees, as claimed in claim 8, is considered new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-11 claim language is unclear as to how the first and second legs could be joined at the angles recited in claims 8-11, which are dependent on independent claim 1, when claim 1 states that the first and second legs are joined at a 90 degree angle.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2859

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Torezon (U. S. Patent No. 4,573,276).

Torezon teaches a workpiece positioning tool (10) comprising: a generally flat base (13, 14) member for supporting a workpiece thereon, said base member having first (13) and second (14) legs joined at a 90 degree angle (Fig. 1), said first and second legs having front edges and back edges (Fig. 1), said first and second legs unobstructed leg ends and unobstructed front edges (Fig. 1), a first sidewall (11) connected to said back edge of said base member first leg at a generally right angle to said flat base member (Fig. 1), a second sidewall (12) connected to said back edge of said base member second leg at a generally right angle to said flat base member (Fig. 1), said second sidewall having a first end adjacent said first sidewall and an unobstructed second end (Fig. 1), and said first sidewall having a first end adjacent said second sidewall, and an unobstructed second end (Fig. 1), a void extending upwardly from said base member and between said first and second adjacent ends (Figs. 1 and 2).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2859

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torezon in view of Boelling (U. S. Patent No. 5,855,073).

Torezon discloses the workpiece positioning tool as described above in paragraph 4.

Torezon does not disclose a tool comprising a plurality of voids in said base member and said first and second sidewalls.

Boelling discloses a workpiece positioning tool (10) comprising a generally flat base member (20), said base member having first and second legs (20) joined at a 90 degree angle (Fig. 1), said first and second legs having front (16) and back (18) edges, a first sidewall (18) connected to said back edge of said base member first leg at a generally right angle to said flat base member (Fig. 1), a second sidewall (18) connected to said back edge of said base member second leg at a generally right angle to said flat base member (Fig. 1), said second sidewall having a first end adjacent said first sidewall and an unobstructed second end (Fig. 1), and said first sidewall having a first end adjacent said second sidewall, and an unobstructed second end (Fig. 1), a void (Fig. 1) extending upwardly from said base member and between said first and second adjacent ends; and a plurality of voids (24, 22, holes in 20) in said base member and said first and second sidewalls (Figs. 1-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the workpiece positioning tool of Torezon to include a plurality of voids in the base member and sidewalls, as taught by Boelling, so that a user could securely mount the tool to a workpiece (Boelling, Col 2, lines 30-40 and Fig. 7).

12. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torezon in view of Thiel (U. S. Patent No. 3,367,224).

Art Unit: 2859

Torezon discloses the workpiece positioning tool as described above in paragraph 4.

Torezon does not disclose a tool wherein said first and second legs of said generally flat base member are joined at a 22.5, 30, 45, or 60 degree angle.

Thiel discloses a workpiece positioning tool (Fig. 1) wherein the angle between the first (21) and second (23) legs of the base member are at angles other than 90 degrees (Fig. 3, Col 2, lines 53-72 and Col 3, lines 1-5 and lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Torezon to have the base legs at angles other than 90 degrees, as taught by Thiel, so that other angular measurements could be made (Thiel, Col 3, lines 1-5 and lines 45-50).

Regarding the angle between the first and second legs of the base: Torezon and Thiel disclose an workpiece positioning tool where the angle is variable from 90 degrees but do not specifically states a particular value for this angle. However, to choose a an angle of 22.5, 30, 45, or 60 degrees between the legs, absent any criticality, is only considered to be the “optimum” value of the angle between the legs, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Response to Arguments

13. Applicant's arguments with respect to claims 1, 2, 8-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents disclose workpiece positioning devices Louis (U. S. patent No. 6,449,855), Boelling (U. S. Patent No. Des.426,127), Fink (U. S. patent No. 5,524,353), and Dadisman (U. S. Patent No. 5,142,787).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2859

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC
April 22, 2003



Diego Gutierrez
Supervisory Examiner
Tech Center 2800